U.S. Patent Appln. No. 09/910,187
Response Dated Dec. 19, 2005
Reply to Office Action of Sep. 20, 2005
Docket No. BOC9-2000-0059 (194)

REMARKS/ARGUMENTS

These remarks are submitted in response to the Final Office Action dated September 20, 2005. As this response is timely filed within the 3-month shortened statutory period, no fee is believed due

In the Office Action, Claims 1-8, 10-16, 18-28, 30-36, 38-42, and 44 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,807,562 to Pennock, *et al.* (hereinafter Pennock). Claims 9, 17, 29, 37, and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pennock in view of U.S. Published Patent Application No. 2002/0060988 to Shtivelman (hereinafter Shtivelman).

Applicants have amended independent Claims 1, 10, 21, 30, 41, and 44 to emphasize certain aspects of Applicants' invention. Dependent Claims 3, 12, 18, 23, 32, and 38 have been amended, and dependent Claims 4, 11, 24, and 31 cancelled, to maintain consistency among each of the claims. As discussed herein, the claim amendments are supported throughout the Specification. (See, e.g., Specification, p. 3, lines 15-12; p. 4, lines 18-22; p. 5, line 14 - p. 6, line 5; and p. 10, line 22 - p. 11, line 4.) No new matter has been introduced by the claim amendments.

I. Applicants' Invention

It may be useful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, typified by independent Claim 1, as amended, is an instant message (IM) communication method.

The IM communication method can include inserting, in an IM, a voice communications identifier. The method further can include embedding computer program code within the IM. The computer program code, moreover, can be configured to establish a voice communications link between a recipient and a sender of the IM. (See, e.g., Specification, p. 10, line 22 - p. 11, line 4.) Additionally, the method can include

{WP273360;1}

12

transmitting the IM to the recipient and, responsive to the recipient selecting the voice communications identifier, establishing a voice communications link between the recipient and sender of the IM. More particularly, according to the method, the voice communications link can be established by executing the computer program code embedded in the IM.

II.   The Claims, As Amended, Define Over The Prior Art

As already noted, independent Claims 1, 10, 21, 30, 41, and 44 were each rejected as being anticipated by Pennock. As discussed herein, Pennock is directed to a method and system for selecting contacts who can participate in a voice chat session over a data communications network. (Col. 1, line 66 - Col. 2, line 3; see also Abstract.)

Applicants respectfully submit that Pennock fails to expressly or inherently teach every feature recited in each of the independent claims, as amended. For example, Pennock fails to teach, expressly or inherently, the embedding, in an IM, of computer program code that is configured to establish a voice communications link with a sender and a recipient of the IM, as recited in each of amended independent Claims 1, 10, 21, 30, 41, and 44. Pennock further fails to expressly or inherently teach the extraction or the execution of such computer program code in response to a recipient selecting a communications identifier, such as selectable icon, so as to establish a communications link, as also recited in each of the amended independent claims.

At page 2 of the Office Action, it is stated that these features are found in FIG. 15 of Pennock. Applicants respectfully note, however, that FIG. 15 illustrates only a "gaming utility 30 UI 32 [user interface]," which as described has been "expanded" by user contemplating joining a chat session in order to participate online in a "multi-party game." (See Col. 14, lines 29-46.) The figure does not pertain to a computer program code embedded in an IM message. More fundamentally, the figure does not disclose,

expressly or inherently, embedded computer program code that establishes a communications link between a recipient and a sender of a message, as recited in amended independent Claims 1, 10, 21, 30, 41, and 44.

Pennock nowhere teaches, expressly or inherently, embedding computer program that can be received and selected by a recipient to establish a communications link between the recipient and a sender. Pennock, throughout the reference, describes an exemplary configuration of an "online gaming environment." (See Col. 4, lines 45-65; see also FIG. 1.) Game participants join a chat session by express invitation communicated over a data communications network, such as the Internet, or by joining an "open" chat session hosted by one of the participants. (See Col. 9, lines 7-67.)

As already noted, however, a fundamental difference between Pennock and Applicants' invention is that none of the Pennock gaming participants receive embedded program code that facilitates their joining a chat session. Instead, as made explicit throughout the reference, Pennock participants, whether joining an open chat session or joining one by express invitation, join in the same way: by launching and executing a "gaming utility 30" on the participant's own computing device. See, e.g., Col. 5, lines 19-44.) No participant in Pennock receives program code of any kind that can then be used to establish a communication link.

Instead, with Pennock, a gaming participant connects with other participants using a gaming utility already residing on the participants' computing device. Either the participant logs onto an MS messenger service and then launches the gaming utility, or the gaming utility automatically connects the participant to the communications network. (Col. 5, lines 19-26.) In either event, though, the participant connects to other participants using the "internal functions provided by the gaming utility" already running on the participant's computing device.

U.S. Patent Appln. No. 09/910,187
Response Dated Dec. 19, 2005
Reply to Office Action of Sep. 20, 2005
Docket No. BOC9-2000-0059 (194)

The UI Frame illustrated in FIG. 15 of Pennock is merely exemplary of a user interface that contains a "chat pane." (Col. 14, lines 38-43.) The chat pane in Pennock, however, does not include computer program code for connecting the recipient of the chat pane to the chat session. The gaming utility that is already running on the participant's computer device provides the "internal functions" for establishing the chat session, as already pointed out. The chat pane in Pennock merely indicates a "chat channel" assigned to the participant if the participant elects to join the chat session. If the participant elects to join, the gaming utility on the participant's computer device establishes a link to the chat session.

This fundamental distinction is underscored by noting that, elsewhere, Pennock describes the chat panel as including an IP address that the gaming utility uses to link the participant to the chat session. Nowhere, however, is there any suggestion that the chat panel provides embedded computer code for linking the participant to the chat session. Linking, throughout Pennock, is done by the gaming utility running on the participant's computing device. A potential gaming participant in Pennock receives an open or express invitation to join in gaming, and accordingly, a designated chat channel. Nowhere in Pennock, however, does a recipient receive an IM that contains embedded computer programming code for establishing a link to other participants, as recited in each of amended independent Claims 1, 10, 21, 30, 41, and 44.

Applicants respectfully maintain, therefore, that Pennock fails to expressly or inherently teach every feature recited in the amended independent Claims and that the claims define over the prior art. Applicants further respectfully maintain that whereas each of the remaining dependent claims depends from one of the amended independent claims, the dependent claims likewise define over the prior art.

U.S. Patent Appln. No. 09/910,187
Response Dated Dec. 19, 2005
Reply to Office Action of Sep. 20, 2005
Docket No. BOC9-2000-0059 (194)

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: **December 19, 2005**

Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Marc A. Boillot, Registration No. 56,164
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000

{WP273360;1}   16